

REMARKS

Claims 14-17, 21-36, and 45-55 are now pending in the application, with Claims 1-13 and 44 having been canceled, Claims 18-22 and 37-43 having been withdrawn, and Claims 45-55 having been added. Claims 14-17, 23, 26, 31-33, 35, and 36 are amended herein.

Claims 14, 16, 17, and 35 have been redrafted as independent claims. Claim 15 has been amended to depend from Claim 14, rather than from canceled Claim 1; Claim 23 has been amended to depend from Claim 14; and the subject matter of currently canceled Claims 2-12, which depended from original Claim 1, have been rewritten as new Claims 45-55, which depend from Claim 14. Claims 26, 31-33, and 36 have been amended to address minor informalities.

Amendments to the claims contained herein are intended to be of equivalent scope as originally filed and, thus, are not narrowing amendments.

Paragraphs [0014], [0024], [0035], [0036], [0047], [0048], and [0049] of the Specification have been amended to recite subject matter of various rejected claims. Support for these amendments is found in the respective claims as further described below.

The Examiner is respectfully requested to reconsider and withdraw the objections and rejections in view of the amendments and remarks contained herein.

SPECIFICATION

The specification stands objected to for certain informalities. Applicants have amended the specification according to the Examiner's suggestions. Therefore,

reconsideration and withdrawal of this objection are respectfully requested. Further Specification objections are addressed below.

REJECTIONS UNDER 35 U.S.C. § 112 AND FOR LACK OF ANTECEDENT BASIS

Claims 2, 3, 8-9, 10-12, 16-17, 29, 31-32, 35-36, and 44 stand either as rejected under 35 U.S.C. § 112, first or second paragraph, or as insufficiently supported by the Specification, which now stands objected to for failing to provide antecedent basis for subject matter recited in these claims.

The subject matter of Claims 2 and 3 (now of Claims 45 and 46, respectively) has been added to paragraphs [0048] and [0049] of the Specification. The subject matter of Claims 8, 9, and 10-12 (now of Claims 51, 52, and 53-55, respectively) has been added to paragraph [0047]. The subject matter of Claim 16 is supported in Example 7. See page 16, Table 1, column 8, of the Specification. Claim 17 has been amended to remove Pr and Dy. Claim 44 has been canceled.

The Claim 24 recitation of alkaline-earth silicate glasses has been added to paragraph [0024]. In addition, Claim 24 does not recite embodiments of lanthanum oxide borate glasses that fall outside the scope of Claim 23, from which Claim 24 depends. Because Claim 24 depends from Claim 23, the lanthanum oxide borate glasses recited therein would include embodiments of lanthanum oxide borate glasses that necessarily contain ≤ 1 wt.% of B_2O_3 . Because Claim 24 incorporates all limitations of Claim 23, it could not include the particular borate glass described in U.S. Patent No. 3,254,031.

Support for the subject matter of Claim 29 is found in the Abstract of the present Application, and has further been added to paragraph [0014] of the Specification. The subject matter of Claims 31 and 32 has been added to paragraph [0035]; and the subject matter of Claims 35 and 36 has been added to paragraph [0036] of the Specification.

Applicants believe that these remarks and amendments overcome the rejections and objections and respectfully request that they be withdrawn.

PROVISIONAL REJECTION FOR STATUTORY DOUBLE PATENTING

Claims 23-33 stand provisionally rejected for statutory double patenting over Claims 8-17 of copending Application No. 11/116,004. Claim 23, from which Claims 24-33 depend, has been amended to depend from Claim 14, as amended herein. Applicants believe that the cited claims do not describe every element of the invention defined by the claims as presently amended herein, and thus that these inventions are distinct. Applicants believe that these remarks and amendments overcome the rejection and respectfully request that it be withdrawn.

REJECTION FOR NON-STATUTORY "OBVIOUSNESS-TYPE" DOUBLE PATENTING

Claims 1-4, 7-12, 23, and 27-29 stand rejected for non-statutory, obviousness-type double patenting over Claims 1-15 of U.S. Patent No. 6,853,659. Claim 1 has been canceled; Claims 2-4, 7-12, 23, and 27-29 have been amended to depend from Claim 14, as amended herein.

Applicants believe that the cited claims do not provide any grounds for one of ordinary skill in the art to have made the presently claimed invention or to have formed a reasonable expectation of success in obtaining a glass having the advantageous properties of those defined by the claims as presently amended. Applicants believe that these remarks and amendments overcome the rejection and respectfully request that it be withdrawn.

PROVISIONAL REJECTION FOR NON-STATUTORY “OBVIOUSNESS-TYPE” DOUBLE PATENTING 1

Claims 23, 25, 26, 28, and 29 stand provisionally rejected for non-statutory, obviousness-type double patenting over Claims 1, 7, and 13-18 of copending Application No. 10/378,945. Claim 23, from which the remaining rejected claims depend, has been amended to depend from Claim 14, as amended herein. Applicants believe that the cited claims do not provide any grounds for one of ordinary skill in the art to have made the presently claimed invention or to have formed a reasonable expectation of success in obtaining a glass having the advantageous properties of those defined by the claims as presently amended. Applicants believe that these remarks and amendments overcome the rejection and respectfully request that it be withdrawn.

PROVISIONAL REJECTIONS FOR NON-STATUTORY “OBVIOUSNESS-TYPE” DOUBLE PATENTING 2

Claims 1-15, and separately Claims 23, 25, 26, 28, 29, and 34, stand provisionally rejected for non-statutory, obviousness-type double patenting respectively over Claims 1-7 of copending Application No. 11/116,004, and over Claims 1-8 and 10-19 of copending Application No. 11/236,756.

Applicants have concurrently with this Response filed a Terminal Disclaimer over copending Application Nos. 11/116,004 and 11/236,756. Applicants believe that these remarks and submission overcome the rejections and respectfully request that they be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 102

1. Claims 23, 25, 26, 28, and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,251,062;
2. Claims 23, 24, and 28-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 3,374,381;
3. Claims 23-26 and 28-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 3,629,137;
4. Claims 23, 24, and 28-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 3,654,172;
5. Claims 23-26 and 28-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 3,677,960;
6. Claims 1, 2, 5, 7, 10-13, 23, 25, 28, and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by EP 709345;
7. Claims 1, 2, 23, 28, and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 4,075,120;
8. Claims 1-6, 23, 25, 26, 28, 29, and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 4,239,645;

9. Claims 1-6, 10, 23, 25, 26, 28, 29, and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by any one of U.S. Pat. Nos. 4,929,387; 5,032,315; or 5,526,369;
10. Claims 1-6, 10, 11, 23, 28, 29, and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,334,559;
11. Claims 1-6, 10, 23, 28, 29, and 44 stand rejected under 35 U.S.C. § 102(b and e) as being anticipated by U.S. Pat. No. 6,430,349;
12. Claims 1-6, 10, 11, 13, 23, 28, 29, and 44 stand rejected under 35 U.S.C. § 102(b and e) as being anticipated by U.S. Pat. No. 4,134,851;
13. Claims 23, 25, 26, 28, and 29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 5,251,062; and
14. Claims 1-12, 23, 28, 29, and 44 stand rejected under 35 U.S.C. § 102(e) as being anticipated by any one of U.S. Patent Publication No. 2004/0042515 or U.S. Pat. No. 6,853,659.

Applicants have amended or canceled each of these rejected claims or the claims from which they depend. Applicants believe that the cited reference do not describe every feature of the invention as defined by the presently amended claims. Applicants believe that these remarks and amendments overcome the rejection and respectfully request that it be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

1. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,134,851;
2. Claims 1, 2, 5, 7, 10-13, and 27-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 709345;
3. Claims 1-6, 23, 28, 29, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,075,120;
4. Claims 1-6, 23, 25, 26, 28, 29, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,239,645;
5. Claims 1-6, 10-13 23, 25, 26, 27, 28, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of U.S. Patent Nos. 4,929,387; 5,032,315; or 5,526,369; and
6. Claims 1-6, 10-13, 23, 27, 28, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,334,559.

Applicants have amended or canceled each of these rejected claims or the claims from which they depend. Applicants believe that the cited references do not provide any suggestion or description (1) that would have guided one of ordinary skill in the art to have made the presently claimed invention or (2) that would have provided grounds for one of ordinary skill in the art to have formed a reasonable expectation of success in obtaining a glass having the advantageous properties of those defined by the claims as presently amended. Applicants believe that these remarks and amendments overcome the rejections and respectfully request that the be withdrawn.

ALLOWABLE SUBJECT MATTER

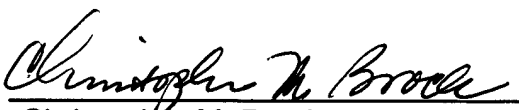
The Examiner states that Claims 16, 17, 35, and 36 would be allowable if rewritten in independent form. Accordingly, Applicants have amended claims 16, 17, and 35 to include the limitations of the base claim and any intervening claims. Therefore, Claims 16, 17, and 35 should now be in condition for allowance.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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